

**REMARKS-General**

1. The claims 1, 7-9, 20, 22-24, and 29-40 are amended to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112. No new matter has been included.

**Response to Rejection of Claims 7, 39 and 40 under 35USC112**

2. The applicant submits that the claims 1 to 40 as amended particularly point out and distinctly claim the subject matter of the instant invention, as pursuant to 35USC112.

**Response to Rejection of Claims 1-4, 10, 11, 16, 17, 25, 26, 33, 34, 39, 40 under 35USC102(e)**

3. Pursuant to 35 U.S.C. 102, "a person shall be entitled to a patent unless:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

In view of 35 U.S.C. 102(e), it is apparent that a person shall not be entitled to a patent when his or her invention was described in an application patent which is published under section 122(b) by another filed in the United States before the invention by the applicant for patent.

4. However, Dukask et al and the instant invention are not the same invention according to the fact that each of the independent claims 1, 4, 10, 15, 17, 39, 71, 72, 84, 92, 97, and 99 of Dukask et al, which specifically claims displaying of visible electronic information on a **moving vehicle** and **sensing geographical location of the vehicle**, does not read upon the instant invention and the independent claims 1 and 39 of the

instant invention does not read upon Dukask et al too because of the fact that the instant invention is for stationary electronic poster. In addition, Dukask et al fails to anticipate the following distinctive features as claimed in claims 1-4, 10, 11, 16, 17, 25, 26, 33, 34, 39, and 40 of the instant invention:

(i) providing a plurality of **regional service centers and regional control centers** in a plurality of regional territories and a central control system networked with the regional service and control centers through a public network, wherein since Dukask et al focused in mounting display on a moving vehicle so that Dukask do not need to have any regional service centers and regional control centers networked with the central control system, but rather Dukask et al needs to provide a location sensing process to locate the moving vehicle while the instant invention does not include any of such steps;

(ii) the stationary electronic posters in each of the regional territories being **maintained and controlled by the respective regional control center**, wherein Dukask et al does not involved such regional control center because the moving vehicle is moving around;

(iii) **accepting posting orders from advertisers by the regional service centers**, wherein ***each of the regional service centers obtains information of where and when is each of the electronic posters available*** for whatever posting size from the central control system through the public network, wherein Dukask et al requests the advertisers to upload their advertisements and scheduling/timing criteria to a system that can be controlled by a computer system, such as an e-commerce site and no regional service centers are provided for the user to obtain information of where and when is each of the electronic posters available for whatever posting size from the central control system;

(iv) **sending each of the posting orders to the central control system from the respective regional service center**, wherein each of the posting orders includes posting information of posting content, time and size for one or more of the electronic posters designated by the respective advertiser, wherein Dukask et al neither provides any regional service centers nor services therefrom;

(v) **sending the recorded poster content to the regional control centers in charge of the electronic posters designated by the respective advertiser**, wherein Dukask et al neither provides any regional service centers nor services therefrom;

(vi) **booking and confirming advertising time with one or more of the regional control centers controlling the electronic posters** designated by the respective advertiser by the central control system, wherein Dukask et al does not provide such step;

(vii) **displaying** the recorded poster content in each of the electronic posters designated by the respective advertiser **in the designated size and time by the respective regional control center** while each of the electronic posters is always remained electronically controlled by the respective regional control center, wherein Dukask et al does not provide any regional control center;

(viii) affirming the posting orders by the central control system by **confirming posting schedules of each of the posting orders with one or more of the regional control centers** that in charge of the electronic posters designated by the respective advertiser, wherein Dukask et al fails to suggest any regional control centers because of the fact that the advertisement of Dukask et al is displayed on a moving vehicle, so that to detect where is the vehicle is the most essential concept suggested by Dukask et al;

(ix) each of said posting orders for each of said electronic posters being sent with a **posting code which includes at least a poster code assigned to represent said electronic poster**, wherein Dukask et al does not have any posting code;

(x) downloading said poster contents of said posting orders to said **corresponding regional control centers**, wherein Dukask et al suggests no regional control centers; and

(xi) monitoring each of the electronic posters through the public network, wherein a monitor device is **installed adjacent to each of the electronic posters for monitoring each of the electronic posters in live time manner and sending back a feedback and posting status instantly to the regional control center and the central control system** through the public network, wherein Dukask et al merely anticipates a

camera on the display to derive information about potential audience while the instant invention teaches the user of monitor device to monitoring the electronic poster itself for feedbacking the posting stage instantly in live time manner to both the regional control center (Dukask et al does not have such control center) and the central control system for best and instant control of the advertisement content and time.

5. In view of above, Dukask et al fails to anticipate the instant invention as claimed in 1-4, 10, 11, 16, 17, 25, 26, 33, 34, 39, 40 of the instant invention. The applicant believes that for all of the foregoing reasons, the claims are in condition for allowance and such action is respectfully requested.

**Response to Rejection of Claims 7-9, 12-15, 18-24, 27-32, and 35-38 under 35USC103(a)**

6. In view of above, the independent claim 1 as amended of the instant invention is allowable over Dukask et al because Dukask et al fails to suggest or anticipate the above distinctive features (i)-(xi) of the instant invention. The Examiner rejected claims 7-9, 12-15, 18-24, 27-32, 35-38 over Dukask et al and rejected claims 5 and 6 over Dukask et al in view of Rakavy et al. The applicant respectfully submits that since claims 7-9, 12-15, 18-24, 27-32, and 35-38 are dependent on claim 1, these claims become allowable when claim 1 as amended is allowable over Dukask.

7. In addition, the applicant respectfully submits that the invention must be considered as a whole and there must be something in the reference that suggests the combination or the modification. See Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination"), In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") In re Laskowski, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have

made the modification obvious unless the prior art suggested the desirability of the modification.”) In the present case, there is no such suggestion.

8. The applicant also respectfully submits that “The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art.” Libbey-Owens-Ford v. BOC Group, 4 USPQ 2d 1097, 1103 (DCNJ 1987). In any case, even combining Dukask et al and Rakavy et al would not provide the invention as claimed -- a clear indicia of nonobviousness. Ex parte Schwartz, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992), (“Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed.”).

9. Applicant believes that neither Dukask et al nor Rakavy et al, separately or in combination, suggest or make any mention whatsoever of the following distinctive features in addition to the above described distinctive features (i)-(xi).

(xii) **providing a suggested schedule and reference** for different categories of services and products **by each of said regional control centers to said central control system** to post advertisements thereof in different time period a day in each of said electronic posters within said regional territory, wherein neither Dukask et al nor Rakavy et al fails to suggest any regional control centers and suggested schedule and reference; and

(xiii) **each of the regional service centers and regional control centers being assigned with a service code and a control code respectively**, wherein in each of said posting orders, the service code clearly indicates which of the regional service centers does the posting order and the control code indicates which of the regional control centers in charge the electronic poster, wherein Dukask et al suggests neither regional service centers nor regional control centers so that no service code and control code for posting order is required.

10. The applicant respectfully alleges that “To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In

other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited art references for combination in the manner claimed... [T]he suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness..." In re Gorman, 933 F.2d 982, 986, 18 USPQ 2d 1885, 1888 (Fed. Cir. 1991). Also, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

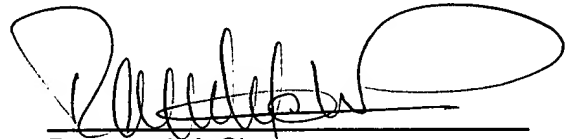
11. The Office Action fails to provide a reasoned analysis on why one of ordinary skilled in the art would have suggested or provided what are claimed in the claims 7-9, 12-15, 18-24, 27-32, 35-38 of the instant invention.

#### **The Cited but Non-Applied References**

12. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

13. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the rejection are requested. Allowance of claims 1 to 40 at an early date is solicited.

Respectfully submitted,



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I hereby certify that this corresponding is being deposited with the United States Postal Service by First Class Mail, with sufficient postage, in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: April 19, 2004Signature: 

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